

REMARKS

Claims 1, 2, 4-9, and 11-17 are pending in this application.

Reconsideration in view of the previous amendments, Declaration under Rule 131 and the following remarks, is respectfully requested.

The Office Action rejects, under 35 U.S.C. § 102(e), claims 1, 2, 4-9 and 11-17 over Wagner et al. (U.S. Patent Pub. No. 2003/0066092). This rejection is respectfully traversed.

Applicant respectfully submits that this rejection has been overcome by its submission of the previously filed executed Declaration Under Rule 131 (Declaration).

More specifically, the Declaration executed by Mr. Kotzin, establishes conception of the subject matter of the present application in the United States or other provincial region permitted by Rule prior to the October 1, 2001 effective date of United States Application No. 2003/0066092 A1 entitled “Remote Task Scheduling For A Set Top Box” (Wagner Application) and establishes diligence of the filing of the present application from a time prior to the October 1, 2001 effective date of the Wagner Application to the December 21, 2001 filing date of the instant patent application.

The Examiner has taken the position that the evidence presented has not met the burden under 37 CFR 1.131 (Rule 131). Thus, the subject matter of the rejected claims has been determined not to predate the effective filing date of Wagner. Specifically, the Examiner contends:

1. That the Applicant has not met the burden with regard to conception. Very little evidence was presented regarding conception.
2. That Applicant has not met the burden with regard to the invention being reduced to practice. Applicant has provided no evidence as to reduction to practice. The Examiner cited MPEP 2138.05, for the proposition that reduction to practice requires that the invention existed and worked for its initial purpose. Applicant respectfully disagrees.

Referring to MPEP 2138.04, “Conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without exercise of extensive experimentation or the exercise of inventive skill.” Hiatt v. Ziegler, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). See also Coleman v. Dines, 754 F. 2d 353, 224 USPQ 857 (Fed. Cir.

1985), where it is settled that in establishing conception a party must show possession of every feature recited in the count. Conception must be proved by corroborating evidence.

Applicant's claim 1 is directed to a method for obtaining content for a wireless device comprising: (i) associating a code with at least both a desired server containing desired content and with control description data that defines at least when to start recording the desired content from the desired server; (ii) storing in a code server, the code with associated control description data; (iii) providing, by the code server, at least the stored control description data to the wireless device to facilitate acquisition of content; and (iv) from time to time, sending the code by the wireless device to the code server; and in response to receiving the code, the code server performs the step of providing the stored control description data to the wireless device. In compliance with MPEP 2138.04, Applicant has conceived of the invention, in Mr. Kotzin's Disclosure For Patent Committee dated Dec. 30, 1999 in Exhibit A to the Declaration. More specifically, in Mr. Kotzin's answers to paragraphs 1-6.

Accordingly, Mr. Kotzin's conception is established in Exhibit A and is sufficiently clear to enable one skilled in the art to reduce it to practice without exercise of extensive experimentation or the exercise of inventive skill. Applicant respectfully submits that Applicant's conception is clearly established as detailed herein and is in compliance with the MPEP 2138.04 and the applicable case law. Hiatt v. Ziegler, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973).

Further, in Mr. Kotzin's Disclosure For Patent Committee dated Dec. 30, 1999, in Exhibit A to the Declaration, in paragraphs 1-6, Applicant has established conception by showing possession of every feature recited in the count(Claim 1). Exhibit A is the corroborating evidence for establishing conception. Applicant respectfully submits that the Declaration is in compliance with MPEP 2138.04 and the applicable case law. Coleman v. Dines, 754 F. 2d 353, 224 USPQ 857 (Fed. Cir. 1985).

For the reasons detailed above, Applicant respectfully submits that it has established conception predating Wagner.

Turning now to the subject of reduction to practice, the MPEP 2138.05 states: "Reduction to practice may be an actual reduction or a constructive reduction to practice which occurs when a patent application on the claimed invention is filed."

Applicant's present application with Serial Number 10/037,015 was filed December 21, 2001. Applicant respectfully submits that such application is a constructive reduction to practice, in compliance by the MPEP 2138.05. It is respectfully submitted that no further evidence is required, as this is established law under MPEP 2138.05

In sum, the Declaration executed by Mr. Kotzin, establishes:

1. Conception of the subject matter of the present application in the United States prior to the October 1, 2001 effective date of United States Application No. 2003/0066092 A1 to the Wagner Application; and

2. Diligence (which subject was thoroughly briefed in Applicant's previous Amendment and established in detail in the Declaration) in connection with the filing of the present application from a time prior to the October 1, 2001 effective date of the Wagner Application to the December 21, 2001 filing date of the present application (constructive reduction to practice).

Thus, Applicant respectfully submits that it has effectively sworn behind the Wagner reference pursuant to Rule 131. Therefore, Wagner does not qualify as a prior art reference under 35 U.S.C. § 102(e), by the proofs provided and established in Applicant's Declaration and under Rule 131. Accordingly, Applicant respectfully requests withdrawal of the outstanding rejections.

CONCLUSION

Based on the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1, 2, 4-9, and 11-17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact the undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,

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